

REMARKS

In the Office Action,¹ the Examiner suggested a new title; objected to the specification for informalities; rejected claim 16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; rejected claim 16 under 35 U.S.C. § 112, second paragraph, as being ambiguous or confusing; and rejected claims 16-21 as unpatentable over U.S. Patent No. 4,669,730 to Small ("Small"). Each of these objections and rejections are discussed in the remarks below.

By this amendment, Applicant has amended the title, two paragraphs in the specification, and claims 16 and 21. No new matter is added by these amendments. Support for the amendment made to claim 16 may be found at least on page 4, lines 18-20, of Applicant's original disclosure. Support for the amendment made to claim 21 may be found at least on page 7, lines 8-12, of Applicant's original disclosure. Claims 16-21 are currently pending. Of these, claim 16 is independent.

A. Objections to the Title and Specification

By this amendment, Applicant has amended the title and amended the specification in accordance with the Examiner's recommendations. Therefore, Applicant respectfully requests withdrawal of the objections to the title and specification.

B. Claim Rejections Under 35 U.S.C. § 112

By this amendment, Applicant has canceled the elements of claim 16 that the Examiner could not find support for in Applicant's original disclosure and that were

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

allegedly ambiguous or confusing. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claim 16 under 35 U.S.C. § 112, first and second paragraphs.

C. Claim Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Small. No *prima facie* case of obviousness exists with respect to claims 16-21 for at least the reason that Small, taken alone or in combination with the Examiner's Official Notice, does not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th Ed., Rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004).

For example, amended claim 16 recites, among other things, "operating a random number generator to set a jackpot threshold, and . . . determining a win or no win condition, where a win condition indicates that [a] jackpot total equals or exceeds the set jackpot threshold."

Small discloses a system for promoting or encouraging the use of financial institution transacting devices, such as ATMs and Point of Sale terminals. See Small, col. 2, lines 40-51. Small further discloses generating a random number to compare it with an "account number or other selected user indicia" to determine "whether a winning correlation exists between the two numbers." See col. 2, lines 52-58, and col. 3, lines 30-54. In contrast, claim 16 requires "operating a random number generator to set a jackpot threshold, and . . . determining a win or no win condition, where a win condition indicates that [a] jackpot total equals or exceeds the set jackpot threshold." Thus, the random number in Small is generated for a different purpose and Small determines a win or no win condition in a different manner.

The Examiner's Official Notice, alleging that "it is well taught in the art that a manufacturer or retailer may provide an incentive (dollar amount) to a customer for performing a particular task," fails to cure the deficiency of Small noted above.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 16 under 35 U.S.C. § 103(a). Claims 17-21 depend from and add additional features to independent claim 16. Accordingly, these claims are allowable for at least the reasons set forth above.

Conclusion

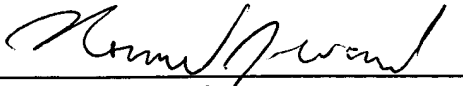
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this reply and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 21, 2005

By: 
Ronald J. Ward
Reg. No. 54,870